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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,245	03/06/2002	John H. Wynne	MM2-114	9277

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,245

Applicant(s)

WYNNE, JOHN H.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 11-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to a method for imprinting indicia markings onto a surface of an object, classified in class 427, subclass 272.
 - II. Claims 11-43, drawn to a peelable stenciling ink, classified in class 523, subclass 160.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product: a process in which the ink is not peeled from the surface, but remains intact as a surface coating.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with William L. Chapin (Reg. No. 27,317) on 2/20/2004, a provisional election was made *with* traverse to prosecute the invention of group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 11-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 60-26039 A (reference made to the English-language translation provided by the USPTO Translations Branch).**

The 039 reference teaches a method for dyeing the surface of an object in which: a semi-liquid, peelable ink is applied to a portion of the surface of the object; sufficient time is allowed for the solvent to evaporate to the ink, thereby forming a solid film peelable from the surface of the object; and the solid film is peeled from the surface of the object leaving the markings behind (abstract; claim; 1:¶2; 4:1-2; and 5:7-6:11). The ink includes a solvent, a dye solubilized therein, and a film-forming substance (4:10-13; 4:18-5:6; and Examples).

The 039 reference states: “masking and dyeing can be simultaneously performed by the use of the dye-containing releasable paint” (4:1-2). It is the examiner’s position that masking the object results in pre-selected regions of the object surface having outline shapes corresponding to indicia to be imprinted and, consequently, reads on this limitation of applicant’s claim.

Further, the 039 reference states: “the dye...is transferred uniformly onto the substrate” (4:20-5:1); and “plastic, wooden, and leather products in particular can be dyed with a colorfast

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color” (4:7-9). Although this reference does not explicitly state that the dye penetrates beneath the surface of the object, as claimed, it is the examiner’s position that this is an inherent feature of the process of this reference. US 1,605,041 A, US 3,830,626 A, and US 3,928,677 A, are cited solely in support of this position, teaching that dyeing of leather, plastic, and wooden objects, respectively, is achieved by the penetration of dye into the pores of these objects.

Lastly, while the 039 reference does not explicitly state that the markings are abrasion and wear resistant, these are physical properties of the resultant dyed substrate. Since this reference teaches all of applicant’s claimed dye composition and process steps, it is the examiner’s position that, unless some essential process step(s) is/are not recited in the claims, the dyed substrate of this reference possesses abrasion and wear resistance. Additionally, applicant, at page 5, lines 12-15 of the spec., discloses that the penetration of the markings beneath the surface of the object is responsible for the abrasion and wear resistance thereof. Consequently, since it has been established above that such penetration is an inherent feature of the process of the 039 reference, abrasion and wear resistance are inherent features as well.

With specific respect to claim 7, the 039 reference teaches several examples of soluble film-forming polymers (4:18-5:6).

With specific respect to claims 9 and 10, the 039 reference teaches that the object may be plastic (4:3-9). It is the examiner’s position that in teaching “plastic” objects, the 039 reference is inclusive of polymeric and thermoplastic objects.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60-26039 A, as applied to claim 1 above, in further view of Lopez (US 4,129,669 A).**

As noted above, the 039 reference teaches masking to apply the ink to a portion of the object's surface. This reference does not teach that the mask is a stencil as disclosed in claims 2 and 3.

Lopez teaches that a coating composition may be selectively applied to the surface of an object (including wood, leather, and plastic) utilizing a stencil. The rear surface of the stencil is conformed to the surface of the object (2:9-20 and 51-63).

It would have been obvious to one of ordinary skill in the art to modify the process of the 039 reference so as to utilize the stencil of Lopez as the mask. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully applying the ink to the surface of the object to form indicia in a variety of desirable patterns.

9. **Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60-26039 A in view of Lopez (US 4,129,669 A), as applied to claim 3 above, in further view of *Hawley's Condensed Chemical Dictionary, 12th Edition*.**

With respect to claim 4, as noted above, it would have been obvious to one of ordinary skill in the art to utilize the stencil of Lopez as the mask. The seal between the surface of the object and the stencil is fluid-tight insofar as it is air-tight (2:9-20). While Lopez does teach that the stencil is adhesive-backed, the reference does not explicitly state that the adhesive is a pressure-sensitive adhesive. Lopez teaches: "The adhesive mass rear surface can be a rubber-

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resin base or some similar material..." (2:9-20). Hawley's teaches that the class of rubber-based adhesives include pressure-sensitive adhesives. It would have been obvious to one of ordinary skill in the art to modify the process of the 039 reference in view of Lopez so as to utilize, as the rubber-resin base adhesive, as pressure-sensitive adhesive. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully adhering the stencil to the surface of the object.

With respect to claim 5, while Lopez does teach that the stencil is removed from the surface of the object, this reference does not explicitly state that the stencil is "peeled" from the surface. It is the examiner's position that the most well-known and expedient method by which to remove an adhesive-backed film or sheet is by peeling and that it would have been obvious to one of ordinary skill in the art to remove the stencil by peeling. Further, it is the examiner's position that Lopez envisions such a removal mechanism because the adhesive and stencil may be re-used (i.e., are not damaged by the removal process) (2:9-10).

With respect to claim 6, since the 039 reference is silent with respect to substrate damage and does not disclose any particular precautions to avoid such damage, it is the examiner's position that such damage does not occur. Further, since the 039 reference teaches that the ink may be applied to paper products (4:3-9), like the stencil of Lopez, it is the examiner's position that the ink will tightly adhere thereto as well.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The definition of "plastic" from *Hawley's Condensed Chemical Dictionary*, 12th Ed., is cited to show that this term is inclusive of polymeric and thermoplastic materials.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPF 3/2/2004
William P. Fletcher III
Examiner
Art Unit 1762


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